

### REMARKS

Reconsideration and allowance are respectfully requested.

Applicant appreciates the allowance of claims 7-14 and 16-19. Allowance of all the remaining claims is requested.

Claims 2-6 are patentable under 35 U.S.C. 112, first paragraph.

It is apparent from the drawings and specification that the rims provide guides and strength to the features on which they are provided. The Examiner has not provided substantiating evidence for rejecting the claims defining the rims. Thus, it is not clear whether the Examiner objects to the specification on the basis of written description or enablement.

In fact, it appears that the Examiner objects to the specification on the basis of written description and enablement as if they were only one basis. Our reviewing court has made it clear that written description and enablement are separate requirements under the first paragraph of 35 U.S.C. § 112. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).

#### **Description Requirement:**

"The function of the description requirement [of the first paragraph of 35 U.S.C. § 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.," In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations

exactly.... but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented... including those limitations." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) citing In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985), citing In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In reviewing the original claims as filed, Applicants claimed a rim around the flat body and a rim around the U-shaped opening. Thus, Applicants had possession, as of the filing date of the application relied on, of the specific subject matter directed to the rim and its relative thickness or thinness.

Further evidence that Applicants had possession of this invention is found in the specification and drawings. Therefore, the Examiner's rejection based upon the description requirement of 35 U.S.C. § 112 should not be sustained.

**Enablement:**

The Federal Circuit has concluded that "[a] specification may, within the meaning of 35 U.S.C. 112, Paragraph 1, contain a written description of a broadly claimed invention without

describing all species that claim encompasses." Utter v. Hiraga, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988). Further, it has been held that representative samples are not required by the statute and are not an end in themselves." In re Robins, 166 USPQ 552, 555 (CCPA 1970).

Decisions from the Federal Circuit state that an invention is enabling if the amount and kind of experimentation required is reasonable. "The first paragraph of 112 requires nothing more than objective enablement ..." In re Marzocchi, 169 U.S.P.Q. 367 (CCPA 1971), and it is up to the examiner to provide adequate support for the rejection.

In addition, it is improper for the examiner to require supporting evidence when "one of ordinary skill in the art would accept the allegations as obviously correct," In re Jolles, 206 U.S.P.Q. 885 (CCPA 1980). The specification as originally filed, coupled with a basic understanding of the pertinent art, provides an adequate basis for enabling one skilled in the art to carry out the claimed invention.

Claims 1-6 and 15 are patentable under §103(a) over the various combinations of Rotondi, Dreifert, Olsen and Goforth.

Claim 1 distinguishes the invention from Dreifert and Olsen. There is nothing inherent in Dreifert and Olsen to suggest their combination in the way proposed by the examiner.

As previously pointed out, Olsen is a sash lock, not used in casement windows, and Olsen has only one moving part besides pins

52 and 68. Nothing would have suggested using Olsen in a casement window operator.

Dreifert's handle 50 and crank 65 are two pieces (column 9, lines 8-10). Nothing would have suggested a plastic lever connected to the main body and to the plastic sliding tongue, as in claim 1. Nothing in either reference would have suggested sliding a plastic sliding tongue in a plastic polymer housing, as in claim 1.

Nothing in Dreifert, Olsen or Goforth would have suggested their mutual combination in rejecting claims 2, 3, 6, and 15.

Olsen is a lock for sashes. Goforth is a multiple channel two-element lock for sashes. Nothing inherent in those references would have suggested their mutual combination or their further combination with a window and door slide operator shown in Dreifert.

Claim 2 distinguishes from the references in the same manner as claim 1 and adds a relatively thick rim around a sliding tongue flat body. That is not shown in any reference or any part of Goforth.

Claim 3 adds to claims 2 and 1 a relatively thin rim about the U-shaped opening, which would not have been obvious from any of the three references.

Claim 6 adds an oval groove surrounded by an oval rim, which would not have been obvious from any reference. The element 42 is a step, not a rim (column 9, line 24, Figure 6).

Claim 15 points out a plastic main body and plastic cover not obvious from any reference, a central integral cylindrical bearing opening, not found in any reference, and an operating lever having a bearing extending through the housing, not found in any reference. Claim 15 points out the plastic sliding tongue, the U-shaped opening and the thick rim around the tongue body and the thin rim around the U-shaped opening, none of which would have been suggested by the references.

Claim 15 distinguishes the invention from Rotondi and Olsen. Nothing inherent in Rotondi or Olsen would have suggested their mutual combination.

Rotondi has multiple pieces with multiple movements. Olsen has a single moving piece. The two operate differently. Olsen simply holds two parts together.

Neither Rotondi nor Olsen is a casement window operator. Neither has a plastic main body and a plastic cover. Neither has an operating lever with a central cylindrical bearing extending through a central integrally formed bearing opening in a main body. Neither has a plastic sliding tongue with a flat body and thick and thin rims surrounding the flat body and a U-shaped opening, all as set forth in claim 15. Neither has an oval opening surrounded by an oval rim receiving an actuating cylinder, as pointed out in claim 15.

Claim 2-5 and 15 distinguish the invention from a combination of Rotondi, Olsen and Goforth.

Nothing inherent in the three references would have suggested their combination.

Rotondi is a multiple part, multiple movement sash lock.

Olsen is a simple single moving part sash lock.

Goforth is a multi-channel sash lock.

None of the three suggests combination with either of the others.

Claim 2 contains all features of claim 1 and differs from the references, inter alia, by pointing out the relatively thick rim around the flat tongue body.

Claim 3 adds to claim 2 the relatively thinner rim around a U-shaped opening not found in the references.

Claim 4 adds to claim 1 wings and guide lugs on the wings, not found in the references.

Claim 5 adds to claims 4 and 2 cylindrical guides extending from the body opposite the lugs, not found in the references.

Claims 6 and 15 distinguish the invention from Rotondi, Dreifert and Olsen. There is nothing inherent in the references which would have suggested their combination in a manner proposed by the examiner.

Rotondi and Dreifert are multiple part multiple movement devices which operate differently, would not have suggested their combination, and individually would have lead away from the invention.

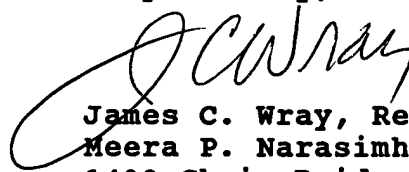
Olsen is a sash lock with one moving piece, which has no relevance to the invention or to Rotondi or Dreifert.

Claim 6 distinguishes the invention from the three references, inter alia, by pointing out, in addition to the structure of claims 1 and 2, an oval groove in the body surrounded by an oval rim. Neither Olsen nor Rotondi has an oval groove, and none of the references has an oval rim.

Claim 15 distinguishes the invention from the references in the ways previously stated. Claim 15 points out a plastic main body and plastic cover not obvious from any reference, a central integral cylindrical bearing opening, not found in any reference, and an operating lever having a bearing extending through the housing, not found in any reference. Claim 15 points out the plastic sliding tongue, the U-shaped opening and the thick rim around the tongue body and the thin rim around the U-shaped opening, none of which would have been suggested by the references.

Reconsideration and allowance of all the claims are respectfully requested.

Respectfully,



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